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10/089,122	03/22/2002	Sunao Takatori	2222.6100001	9087

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

TINKLER, MURIEL S

ART UNIT	PAPER NUMBER
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3691

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03/30/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/089,122	Applicant(s) TAKATORI ET AL.	
	Examiner MURIEL TINKLER	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application has been reviewed. The status of the claims is as follows: claims 1-31 were previously pending; claims 1, 4-6, 11, 24-27 and 29 have been amended; no claims have been added; claim 2 has been cancelled; therefore, claims 1 and 3-31 are currently pending and have been examined. The rejection(s) are as follows.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 18, 2010 has been entered.

Response to Arguments

1. Applicant's arguments, see pages 11-15, filed March 18, 2010, with respect to 35 USC 112 Rejection(s) have been fully considered and are persuasive. The Applicant has appropriately amended the claims to overcome said 35 USC 112 Rejection(s) as stated in the Office Action mailed on December 23, 2010. Therefore, the 35 USC 112 Rejection(s) of claims 1-31 has been withdrawn.

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2. Applicant's arguments filed March 18, 2010 have been fully considered but they are not persuasive.

3. In the response filed on March 18, 2010, the Applicant amended the claims however the amendments do not coincide with the written description found in the specification. For example, according to the specification, the only things that are validated are the amount, the store ID information and the customer ID information (see pages 2 and 9 of the specification). There is no mention of authenticating "the transfer source store account information". Additionally, the specification does not specifically say that the customer account is associated with the authenticated customer ID information although the Examiner acknowledges that this could be the case, the Applicant will need to specifically point out in the specification where this disclosed. This point was discussed in the Advisory Action mailed on February 23, 2010. However, a clear answer was not provided in the response filed on March 18, 2010. Therefore, the amendments warrant new grounds of rejection under 25 USC 112, first paragraph and 35 USC 112, second paragraph.

4. Regarding the 35 USC 103 rejection, the Applicant argues that the prior art does not disclose that a second authentication management apparatus receives customer account information of a customer account in which money is deposited. The Examiner disagrees. See figure 3 (element 312), which received customer account information about an account that has money deposited into it.

5. The Applicant further argues that the prior art (Chasko) does not authenticate the customer ID information, the transfer source store account information, and the store ID

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information, but instead validates the authenticity of the original purchase transaction.

The specification does not specifically disclose what the "transfer source store account information" actually is. However, the Applicant points the Examiner to figure 3 (along with other areas in the specification). According to figure 3, there is: 1) an amount inputted; 2) ID information of the customer is obtained; and, 3) ID information of the store and customer are transmitted along with the amount. Therefore, it has been determined that the Applicant is stating that the "transfer source store account information" is actually ID information of the store being transferred. The Examiner asserts that Chasko does all of this (see page 7 of the Office Action mailed on December 23, 2009). Second, it is unclear what the difference between "authenticating" and "validating the authenticity" is. The Applicant will need to further clarify how or why these terms are distinguished according to the specification of this application. This remark was pointed out in the Advisory Action mailed on February 23, 2010 and there no explanation provided in the response filed on March 18, 2010.

Claim Rejections - 35 USC § 112

35 USC 112, first paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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7. Claims 1 and 3-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. The claims were amended in the response filed on March 18, 2010. However the amendments do not coincide with the written description found in the specification. For example, according to the specification, the only things that are validated are the amount, the store ID information and the customer ID information (see pages 2 and 9 of the specification). There is no mention of authenticating "the transfer source store account information". Therefore, this act of authenticating transfer source store account information was not a part of the original application when filed.

35 USC 112, second paragraph

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1 and 3-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. The term "transfer source store information" in claim 1 is a relative term which renders the claim indefinite. The term "transfer source store information" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite

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degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

12. The Applicant attempted to clarify what this “transfer source store information was” in the response after final mailed on February 23, 2010, by pointing to figure 3 and paragraphs [0005], [0010], [0011], [0047] and [0051]-[0055]. However, these paragraphs did not explicitly state what the “transfer source store information” actually is. For the purposes of compact prosecution, the Examiner has attempted to guess that the transfer source store information is: store ID information being transferred. Other independent claims 4 and 24-27 contain similar language. Additionally, the dependent claims do not cure this deficiency and are therefore also rejected.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 3-6, 11 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko (US 6,738,749 B1) in view of Joao et al. (US 6,047,270), hereafter referred to as Chasko and Joao respectively.

15. Claims 1, 4-6, 11 and 24-27 discuss an authentication management apparatus, comprising: storage means for storing a plurality of pieces of customer ID information

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and a plurality of pieces of store ID information; reception means for receiving a piece of customer ID information, a piece of store ID information, and amount information indicating a monetary amount from a store communication terminal; authentication means for authenticating the piece of customer ID information and the piece of store ID information that have been received by the reception means; and transfer means for transferring the monetary amount indicated by the amount information from an account of a store with the authenticated piece of store ID information to an account of a customer with the authenticated piece of customer ID information. Chasko discloses:

- a storage means for storing a plurality of pieces of customer ID information and a plurality of pieces of store ID information in the Abstract, Background of the Invention, Summary of the Invention, figure 1 (element 112), figure (elements 221 and 232), column 4 (lines 27-48), column 5 (lines 1-48), column 7 (lines 49-67) and column 8 (lines 1-17 and 38-42);
- a reception means for receiving a piece of customer ID information, a piece of store ID information, and amount information indicating a monetary amount from a store communication terminal in figure 1 (elements 121, 124, 125 and 130), column 3 (lines 58-67) and column 4 (lines 1-10);
- an authentication means for authenticating the piece of customer ID information the transfer source store account information, and the piece of store ID information that have been received by the reception means in the Field of the Invention, Background of the Invention, Summary of the Invention, figure 3 (element 308),

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figure 3a (element 358), figure 5 (element 504), column 3 (lines 50-57), column 4 (lines 27-63), column 5 (lines 20-40) and column 7 (lines 19-28).

- A second authentication management apparatus of an authentication manager, wherein the second authentication management apparatus is configured to receive information of a customer account into which the monetary amount is to be deposited, see figure 3 (element 312, central database).
- and a transfer means for transferring the monetary amount indicated by the amount information from a store account indicated by the authenticated transfer source store account information to the customer account associated with the authenticated customer ID information: see the processing of transactions in the Field of the Invention, Background of the Invention (column 10, line 61 through column 11, line 23), figure 1 (element 113), figure 7a (element 706), figure 8 (element 806), figure 8a (element 858), figure 9 (element 906), figure 10 (element 1008), figure 11 (element 1104), column 7 (lines 49-67) and column 8 (line 1) through column 11 (line 50).

However, Chasko does not disclose the use of a receiver configured to receive customer ID information from a mobile communication device. Joao teaches a receiver (central processing computer) configured to receive customer ID information from a mobile communication device in column 10 (lines 8-42). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Chasko to include the use of a mobile communications device because of added security (it allows informs the wireless owner when/how/where the device has been used without permission, see Joao column 10 [lines 43-59]).

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16. Claim 3 discusses an authentication management apparatus in accordance with claim 1, wherein the reception means receives cancel information from the store communication terminal and stops the transfer means from transferring the monetary amount. Chasko and Joao disclose the information in claim 1 see the discussion(s) above. Chasko does not specifically disclose the use of a cancel feature. Joao teaches the use of a cancel feature in column 6 (lines 40-52). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a cancel feature to allow one of the parties to stop the transaction if desired.

17. Regarding claims 28 and 29, Chasko and Joao disclose the information in claims 1 and 4. See the rejection(s) of claims 1 and 4 above. While Chasko does disclose the use of a network (local area network), Chasko does not disclose the use of the Internet. However, Joao discloses the use of the Internet in communicating with mobile devices in column 4 (lines 44-58). Therefore, it would have been obvious to a person having ordinary skill in the art to modify Chasko's local area network to include the use of the Internet, because the Internet was old and well know in the art at the time the invention was made.

18. Regarding claim 30, Chasko and Joao disclose the information in claim 1 above. Chasko does disclose the use of mobile devices (see figure 1, element 131 'smart card'). According the specification, the purpose of inserting the mobile device into the opening (element 900) is for authentication. Chasko discloses the act of authentication and authenticating in column 3 (line 54) through column 4 (line 7).

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19. Regarding claim 31, see the rejection of claim 20 above. Also, Chasko does not specifically discuss the use of mobile phones. However, Joao performs said authentication of mobile devices, see figure 1 (elements 4, 9, 12, and 13) and column 1 (line 66) through column 2 (line 8) and column 10 (lines 7-24). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Chasko to include the use of mobile phones as an alternative to smart cards because it expands the coverage of protection to a user's cell phone which at the time this invention was made, also experienced security breaches (i.e. cloning).

20. Claims 7, 12, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko and Joao as applied to claims 4-6 and 11 above, and in further view of Benton et al. (US 4,625,276 A).

21. Claims 7, 12, 16 and 20 discuss a store communication terminal in accordance with any of claims 4-6 and 11, wherein the store communication terminal is a mobile communication terminal. Chasko and Joao disclose the information in claims 4-6 and 11, see the discussion(s) above. Chasko and Joao do not specifically disclose the use of a mobile terminal. Benton et al. teaches the use of a mobile terminal (portable module) in the Abstract, Technical Field, Background of the Art, Disclosure of the Invention, figure 1a, figure 1b, figure 2 and figure 4. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a mobile communications terminal to speed up account accessibility.

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22. Claims 8, 13, 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko and Joao as applied to claims 4-6 and 11 above, and in further view of Woolston (US 6,085,176 A).

23. Claims 8, 13, 17 and 21 discuss a store communication terminal in accordance with any of claims 4-6 and 11, wherein the store communication terminal is set up in a pawnshop. Chasko and Joao disclose the information in claims 4-6 and 11, see the discussion(s) above. Chasko and Joao do not specifically disclose the use of a terminal at a pawnshop. Woolston teaches the use of a terminal at a pawnshop in column 5 (lines 53-67) and column 6 (lines 1-14). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a pawnshop because it is easily accessibly to the public.

24. Claims 9, 14, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko and Joao as applied to claims 4-6 and 11 above, and in further view of Gustin et al. (US 6,012,048 A).

25. Claims 9, 14, 18 and 22 discuss a store communication terminal in accordance with any of claims 4-6 and 11, wherein the store communication terminal is set up in a lottery money-exchanging booth. Chasko and Joao disclose the information in claims 4-6 and 11 see the discussion(s) above. Chasko and Joao do not specifically disclose the use of a lottery money-exchanging booth. Gustin et al. teaches the use of a lottery money-exchanging booth in the Background of the Invention, Summary of the Invention, column 9 (lines 46-59), column 21 (lines 4-34), column 22 (lines 4-26 and 32-44).

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Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a lottery machine because lottery machines have a large volume of usage and because the purchase of end-user items is less susceptible to fraud, they do not require the additional security for transactions as cashing checks or money orders as discussed in Gusin, Background of the Invention.

26. Claims 10, 15, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko and Joao as applied to claims 4-6 and 11 above, and in further view of Fernandez (US 6,266,647 B1).

27. Claims 10, 15, 19 and 23 discuss a store communication terminal in accordance with any of claims 4-6 and 11, wherein the store communication terminal is set up in a prize-exchanging booth of a pachinko parlor. Chasko and Joao disclose the information in claims 4-6 and 11 see the discussion(s) above. Chasko and Joao do not specifically disclose the use of a pachinko parlor. Fernandez teaches the use of a Pachinko parlor in the Summary of the Invention, column 4 (lines 24-34 and 60-65), column 8 (lines 57-67), column 9 (lines 1-5) and claim 17. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a location that has pachinko games because it is easily accessible to the public.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is

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(571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art
Unit 3691

/M. T./
Examiner, Art Unit 3691